Siti Khadijah Apparel Sdn Bhd v Ariani Textiles & Manufacturing (M) Sdn Bhd

HIGH COURT (KUALA LUMPUR) — CIVIL SUIT NO WA-22IP-23–06 OF 2017
WONG KIAN KHEONG J
10 AUGUST 2018

Copyright — Infringement — Allegation of infringement of copyright of telekung — Whether there were unique features in telekung — Whether telekung constitutes 'graphic work' or 'work of artistic craftsmanship' — Whether there was infringement of copyright — Copyright Act 1987 s 3

This case concerned the copyright of 'telekung', a Muslim prayer outfit. The plaintiff sold 'Telekung Siti Khadijah Klasik' ('the plaintiff's telekung') while the defendant sold 'Ariani x WOW Telekung Nur Aleesya' ('the defendant's telekung'). According to the director of the plaintiff ('SP1'), the defendant copied the plaintiff's *telekung* by way of 'reverse engineering', namely the defendant unstitched the stitches in the plaintiff's *telekung*. Another director of the plaintiff ('SP2'), affirmed a statutory declaration that the plaintiff was the owner of copyright in the plaintiff's *telekung* and the plaintiff's *telekung* was sold through, among others, CJ Wow Shop. After discovering the sale of the defendant's *telekung* through CJ Wow Shop, the plaintiff stopped selling the plaintiff's *telekung* through CJ Wow Shop and hence suffered losses of sales. The defendant submitted that a *telekung* was purely functional and copyright could not subsist in a *telekung*. The defendant further argued that the defendant did not commit any copyright infringement as the defendant's *telekung* was based on a common design of *telekung* which was freely available. According to the defendant, the lace, cloth and rubber used in the defendant's *telekung* was different from those found in the plaintiff's *telekung*. It was also the defendant's defence that the defendant was not aware of the plaintiff's copyright. The main issue that arose was whether a *telekung* constitutes a graphic work or a work of artistic craftsmanship within the meaning of s 3 of the Copyright Act 1987 ('the CA').

Held, allowing the plaintiff's suit:

(1) The plaintiff's *telekung* was created, not copied, by SP1 because SP1 expended sufficient effort, time and expense to make the plaintiff's *telekung* original in character within the meaning of s 7(3)(a) of the CA. The plaintiff's *telekung* is not solely an idea. The plaintiff's *telekung* was also not purely functional. It enables its user to pray but also gave comfort and elegance to the user. The plaintiff's *telekung* was a 'graphic work' as

understood in s 3(a) of the CA and did not constitute a 'work of artistic craftsmanship' under s 3(c) of the CA (see paras 28 & 52).

(2) There was ample proof that SP1 was the author of the plaintiff's *telekung* within the meaning of s 3 of the CA. SP1 had described in detail how she designed the plaintiff's *telekung* over a period of six months in 2010. She had used her skill and time, through trial and error, to design, measure, sew, choose the pattern and cloth material for the plaintiff's *telekung*. SP1 had also incurred expenses in creating the plaintiff's *telekung*. The plaintiff's *telekung* had unique features, namely it will not leave any mark on the user's forehead; the user will be comfortable and appear elegant (see para 31).

(3) The defendant's *telekung* was not created by the defendant or the defendant's designers because the defendant did not call either one of the two defendant's designers to testify. Besides, the drawings and designs of the defendant's *telekung* by the defendant's designers had not been adduced as evidence. The court drew an adverse inference against the defendant under s 114(g) of the Evidence Act 1950 (see para 33).

(4) The plaintiff owned the copyright in the plaintiff's *telekung*. The defendant's *telekung* had copied a substantial part of the plaintiff's *telekung*. This is because the features regarding the sufficient objective similarity constituted a substantial part of the plaintiff's *telekung*. The defendant knew of the plaintiff's copyright as the plaintiff's *telekung* was introduced in the market before the defendant's *telekung* and there was extensive advertisement of the plaintiff's *telekung* in the mass media (see paras 47 & 50).

[Bahasa Malaysia summary

Kes ini melibatkan hak cipta telekung iaitu pakaian solat Muslim. Plaintif menjual 'Telekung Siti Khadijah Klasik' ('telekung plaintif') manakala defendan menjual 'Ariani x WOW Telekung Nur Aleesya' ('telekung defendan'). Menurut pengarah plaintif ('SP1'), defendan meniru telekung plaintif dengan cara 'kejuruteraan terbalik', iaitu defendan menanggalkan jahitan telekung plaintif. Seorang lagi pengarah plaintif ('SP2'), mengesahkan dalam akuan statutorinya bahawa plaintif adalah pemilik hak cipta telekung plaintif dan telekung plaintif telah dijual melalui, antara lain, CJ Wow Shop. Setelah mendapat tahu tentang jualan telekung defendan melalui CJ Wow Shop, plaintif berhenti menjual telekung plaintif melalui CJ Wow Shop dan akibatnya mengalami kerugian jualan. Defendan menghujahkan bahawa telekung adalah secara asasnya bersifat praktikal dan hak cipta tidak boleh wujud dalam telekung. Defendan selanjutnya berpendapat bahawa defendan tidak melakukan pelanggaran hak cipta kerana telekung defendan adalah berdasarkan rekaan biasa telekung yang bebas tersedia. Menurut defendan, renda, kain dan getah yang digunakan dalam telekung defendan adalah

berbeza daripada yang terdapat dalam telekung plaintif. Adalah menjadi pembelaan defendan juga bahawa defendan tidak mengetahui hak cipta plaintif. Isu utama yang timbul ialah sama ada telekung merupakan karya grafik atau karya ketukangan artistik dalam erti kata s 3 Akta Hak Cipta 1987 ('AHC').

Diputuskan, membenarkan guaman plaintif:

(1) Telekung plaintif dicipta, tidak ditiru, oleh SP1 kerana SP1 mengeluarkan usaha, masa dan perbelanjaan untuk menjadikan telekung plaintif bersifat asli dalam pengertian s 7(3)(a) AHC. Telekung plaintif bukan semata-mata idea. Telekung plaintif juga bukan praktikal sepenuhnya. Ia membolehkan pengguna bersolat dan juga memberi keselesaan dan keanggunan kepada pengguna. Telekung plaintif adalah 'kerja grafik' seperti yang difahami dalam s 3(a) AHC dan tidak membentuk 'karya ketukangan artistik' di bawah s 3(c) AHC (lihat perenggan 28 & 52).

(2) Terdapat banyak bukti bahawa SP1 adalah pengarang telekung plaintif dalam pengertian s 3 AHC. SP1 telah menerangkan dengan terperinci bagaimana dia mereka telekung plaintif selama tempoh enam bulan pada tahun 2010. Dia telah menggunakan kemahiran dan masanya, melalui percubaan dan kesilapan, untuk merancang, mengukur, menjahit, memilih pola dan bahan kain untuk telekung plaintif. SP1 juga telah menanggung perbelanjaan dalam mewujudkan telekung plaintif. Telekung plaintif mempunyai ciri unik, iaitu tidak akan meninggalkan apa-apa tanda pada dahi pengguna; pengguna akan berasa selesa dan kelihatan elegan (lihat perenggan 31).

(3) Telekung defendan tidak dicipta oleh defendan atau perekanya kerana defendan tidak memanggil salah seorang daripada dua pereka defendan terdakwa untuk memberi keterangan. Selain itu, lukisan dan reka bentuk telekung defendan oleh pereka defendan tidak dikemukakan sebagai keterangan. Mahkamah membangkitkan anggapan bertentangan terhadap defendan bawah s 114(g) Akta Keterangan 1950 (lihat perenggan 33).

(4) Plaintif memiliki hak cipta dalam telekung plaintif. Telekung meniru sebahagian besar telekung plaintif. Ini kerana ciri-ciri mengenai kesamaan objektif yang mencukupi merupakan sebahagian besar daripada telekung plaintif. Defendan mengetahui hak cipta plaintif kerana telekung plaintif diperkenalkan di pasaran sebelum telekung defendan dan terdapat iklan yang luas tentang telekung plaintif di media massa (lihat perenggan 47 & 50).]

Notes

For cases on infringement in general, see 3(4) *Mallal's Digest* (5th Ed, 2018 Reissue) paras 8091–8144.

Cases referred to

Chuah Aik King (sole proprietor of Syarikat B Three Technology) v Keydonesoft Sdn Bhd [2018] MLJU 530, HC (refd)

Designers Guild Ltd v Russell Williams (Textiles) Ltd [2001] 1 All ER 700, HL (refd)

Dura-Mine Sdn Bhd v Elster Metering Ltd & Anor [2015] 3 MLJ 1; [2015] 1 CLJ 887, FC (refd)

Elster Metering Limited & Anor v Damini Corporation Sdn Bhd & Anor [2012] MLJU 1753; [2012] 1 LNS 959, CA (refd)

F & N Dairies (M) Sdn Bhd v Tropicana Products Inc and other appeals [2013] MLJU 1591, CA (refd)

George Hensher Ltd v Restawile Upholstery (Lancs) Ltd [1975] RPC 31, HL (refd)

Guthrie Sdn Bhd v Trans-Malaysian Leasing Corp Bhd [1991] 1 MLJ 33, SC (refd)

Haji Abdul Ghani bin Ishak & Anor v Public Prosecutor [1981] 2 MLJ 230, FC (refd)

Kiwi Brands (M) Sdn Bhd v Multiview Enterprises Sdn Bhd [1998] 6 MLJ 38; [1998] 2 CLJ Supp 194, HC (refd)

Lau Foo Sun v Government of Malaysia [1974] 1 MLJ 28, FC (refd)

Megnaway Enterprise Sdn Bhd v Soon Lian Hock (sole proprietor of the firm Performance Audio & Car Accessories Enterprise) [2009] 3 MLJ 525, HC (refd)

Merlet & Anor v Mothercare Public Ltd [1984] FSR 358, HC (refd)

Motordata Research Consortium Sdn Bhd v Ahmad Shahril bin Abdullah & Ors [2017] MLJU 1187; [2017] 7 AMR 560, HC (refd)

Munusamy v Public Prosecutor [1987] 1 MLJ 492, SC (refd)

Palm Oil Research and Development Board Malaysia & Anor v Premium Vegetable Oils Sdn Bhd & another appeal [2005] 3 MLJ 97; [2004] 2 CLJ 265, FC (refd)

Pekan Nenas Industries Sdn Bhd v Chang Ching Chuen & Ors [1998] 1 MLJ 465, FC (refd)

Radion Trading Sdn Bhd v Sin Besteam Equipment Sdn Bhd & Ors [2010] 9 MLJ 648; [2010] 6 CLJ 334, HC (refd)

Syarikat Faiza Sdn Bhd & Anor v Faiz Rice Sdn Bhd & Anor and another suit [2017] MLJU 1595, HC (refd)

The New Straits Times Press (M) Bhd & Anor v Admal Sdn Bhd [2013] 6 MLJ 405; [2013] 9 CLJ 955, CA (distd)

Legislation referred to

Copyright Act 1956 [UK] s 3(1)
Copyright Act 1987 ss 3, 3(a), (b), (c), 4(1)(a), 6, 7(1)(c), (2A), (3)(a), (3)(b), (5), (6), 10(1), (2)(a), (3), 13(1)(a), (1)(e), 36(1), 37(1)(d), (7)(c), (8)(c), (8)(h), 42(1)(a)
Copyright, Designs and Patents Act 1988
Evidence Act 1950 ss 4(1), 103, 114(f), (g), 138(4)
Industrial Designs Act 1996 ss 3, 11
Interpretation Acts 1948 and 1967 ss 2(1)(b), 17A, Part I
Trade Descriptions Act 2011 s 5(1)(a)

Ahmad Hafiz bin Zubir (Nasrul Hadi bin Mat Saad with him) (Hafiz Zubir & Co) for the plaintiff.
Habizan Rahman bin Habeeb Rahman (Foong Cheng Leong and Theivini a/p Nayagam with him) (Rahman Rohaida) for the defendant.

Wong Kian Kheong J:

A. ISSUES

[1] This case concerns 'telekung' (a Muslim prayer outfit) sold by the plaintiff company ('the plaintiff') and defendant company ('the defendant').

[2] The plaintiff sells 'Telekung Siti Khadijah Klasik' ('the plaintiff's *telekung*') while 'Ariani x WOW Telekung Nur Aleesya' ('the defendant's *telekung*') is sold by the defendant.

[3] The following issues arise in this case:

(1) whether the court may presume under ss 4(1) and 114(f) of the Evidence Act 1950 ('the EA') that the common course of business regarding the plaintiff's purchase of the defendant's *telekung* from 'CJ WOW Shop' (a media platform which provides for home shopping through television, online and mobile phones) has been followed in this case;

(2) should weight be attached to exh D6 which is not tendered during the cross-examination of SP1 (author of the design of the plaintiff's *telekung*)?

(3) does a *telekung* constitute a 'graphic work' or a 'work of artistic craftsmanship' within the meaning of s 3 of the Copyright Act 1987 ('the CA')? I am not able to find any previous Malaysian case which has construed a 'work of artistic craftsmanship' in s 3 of the CA;

(4) if a *telekung* constitutes a 'graphic work' under s 3 of the CA:

(a) whether a *telekung* is eligible for copyright under the CA in view of

its religious function (for prayers). This is a novel question regarding the interpretation of s 7(2A) and (3)(a) of the CA; and

(b) does the plaintiff own copyright in the plaintiff's *telekung*?

(5) if the plaintiff owns copyright in the plaintiff's *telekung* ('the plaintiff's copyright'), whether the plaintiff's copyright has ceased under the then applicable s 7(6) of the CA. Subsection 7(6) of the CA has now been repealed by Copyright (Amendment) Act 2012 ('Act A1402'); and

(6) if the plaintiff's copyright has not ceased under s 7(6) of the CA, has the defendant infringed the plaintiff's copyright ('copyright infringement') under the first limb of s 36(1) of the CA? In this regard, in a claim of copyright infringement, can the defendant raise as a defence that the defendant is not aware of the plaintiff's copyright and copyright infringement?

B. THE PLAINTIFF'S CASE

[4] The following two witnesses testified for the plaintiff:

(1) Puan Padzilah bt Enda ('SP1'); and

(2) Encik Aminuddin bin Mohd Nasir ('SP2').

[5] SP1, a director of the plaintiff, testified as follows, among others:

(1) SP1 took about six months to design the plaintiff's *telekung* in 2010;

(2) the plaintiff's *telekung* is the first of its kind in the market and has been well received by the public. The plaintiff's *telekung* has been promoted extensively in newspapers, magazines, television, radio and billboards;

(3) the defendant's *telekung* is copied from the plaintiff's *telekung* by way of 'reverse engineering', namely the defendant unstitched the stitches in the plaintiff's *telekung* and copied the design of the plaintiff's *telekung*; and

(4) the defendant's *telekung* was sold by way of pre-paid television advertisement in CJ WOW Shop.

[6] SP2 (SP1's husband) is a director of the plaintiff. According to SP2, among others:

(1) SP2 has affirmed a statutory declaration on 28 March 2017 which stated that the plaintiff is the owner of copyright in the plaintiff's *telekung* ('SP2's SD'); and

(2) the plaintiff's *telekung* is sold through, among others, CJ WOW Shop. After the plaintiff discovered the sale of the defendant's *telekung* through CJ WOW Shop, the plaintiff stopped selling the plaintiff's *telekung*

through CJ WOW Shop in November 2016. Hence, the plaintiff has suffered loss of sales of the plaintiff's *telekung* through CJ WOW Shop.

C. THE DEFENDANT'S CASE

[7] Encik Shafarhan bin Abdul Kahar ('SD1') is the defendant's general manager for sales ('Sales GM'). SD1 gave the following evidence, among others:

(1) the defendant alleges that a *telekung* is purely functional (for religious reasons). Consequently, copyright cannot subsist in a *telekung*;

(2) *telekung* is generally available in public. Accordingly, any information regarding the design of a *telekung* is freely available;

(3) the plaintiff is not the owner of copyright in the plaintiff's *telekung*;

(4) the defendant did not commit copyright infringement because:

(a) the defendant's *telekung* is based on a common design of *telekung* which is freely available;

(b) the defendant's *telekung* is an 'enhanced' version of commonly available *telekung*; and

(c) the lace (renda), cloth and rubber used in the defendant's *telekung* are very different from those found in the plaintiff's *telekung*. In particular, the rubber used in the defendant's *telekung* is very elastic (unlike the one used in the plaintiff's *telekung*) and that is why the defendant's *telekung* is available in one 'free size';

(5) this suit is maliciously filed by the plaintiff to hinder the defendant from competing lawfully with the plaintiff in the *telekung* market;

(6) exh P2 is not the defendant's *telekung* because the size of the lace on exh P2 is different from that in the defendant's *telekung*; and

(7) SD1 adduced exh D6 as the defendant's *telekung*. I will discuss in Part D(2) below on whether any weight should be attached to exh D6 in this case.

D. EVIDENCE

D(1). Exhibits P2, P3 and P4

[8] According to SP1:

(1) the plaintiff had purchased the defendant's *telekung* ('exhs P2 and P3') from CJ WOW Shop;

(2) CJ WOW Shop sent exhs P2 and P3 in in a box (exh P4); and

(3) exh P4 has a label (marked P4A) which stated as follows:

CJ WOWSHOP

www.cjwowshop.com.my

WAYBILL COD

Sender Account:

MP CJ O Shopping Sdn. Bhd.

...

Receiver: NORASHIKIN OTHMAN

... Remark

ARIANI X WOW TELEKUNG NUR

... (Emphasis added.)

[9] The defendant has denied that exh P2 is the defendant's *telekung*. The defendant further contends as follows:

(1) the plaintiff had failed to call a witness from CJ WOW Shop to prove that the plaintiff had indeed purchased exh P2 from CJ WOW Shop;

(2) according to the label ('P4A') on exh P4, the recipient of exh P2 is one Norashikin Othman ('Cik Norashikin'). Cik Norashikin was not called by the plaintiff to testify that she had purchased exh P2 from CJ WOW Shop;

(3) the plaintiff's failure to call the above two witnesses attract an adverse inference against the plaintiff's case under s 114(g) of the EA; and

(4) based on the above reasons, the defendant applied to expunge exhs P2 and P3 as evidence in this case.

[10] Firstly, pursuant to s 114(f) of the EA, the court may presume that the common course of business has been followed in a particular case — please see the Federal Court's judgment delivered by Edgar Joseph Jr FCJ in *Pekan Nenas Industries Sdn Bhd v Chang Ching Chuen & Ors* [1998] 1 MLJ 465 at pp 519–520. Relying on s 114(f) of the EA as interpreted in *Pekan Nenas Industries*, I find that there is a rebuttable presumption as follows:

(1) there had been a purchase of the defendant's *telekung* in exhs P2 and P3 from CJ WOW Shop; and

(2) CJ WOW Shop had sent exhs P2 and P3 in exh P4 ('rebuttable presumption').

[11] Section 4(1) of the EA provides as follows:

4 *Presumption*

(1) Whenever it is provided by this Act that the court may presume a fact, it may either regard the fact as proved unless and until it is disproved, or may call for proof of it. (Emphasis added.)

[12] According to s 4(1) of the EA, when the EA provides that the court may presume a fact (such as the facts presumed by an application of s 114(f) of the EA), the court may 'regard the fact as proved unless and until it is disproved'. Accordingly, based on s 4(1) read with s 114(f) of the EA, once the court presumes that the common course of business (regarding exhs P2, P3 and P4) has been followed:

(1) the rebuttable presumption arises and exhs P2, P3 and P4 are admissible as evidence. Hence, the defendant's application to expunge exhs P2, P3 and P4 cannot succeed; and

(2) the evidential burden then shifts to the defendant to adduce evidence to rebut the rebuttable presumption. No evidence has been produced by the defendant to rebut the rebuttable presumption. Accordingly, I find that the facts presumed in the rebuttable presumption (please see the above para 10) have become irrebuttable.

[13] I attach great weight to exhs P2, P3 and P4 for the following reasons:

(1) SD1 admitted during cross-examination that the defendant's *telekung* was only sold through CJ WOW Shop. According to SD1, CJ WOW defendant's *telekung* and would send boxes (such as exh P4) (CJ WOW Shop's boxes) to the defendant with details of the purchasers. The defendant would then insert the defendant's *telekung* into CJ WOW Shop's boxes and return such boxes to CJ WOW Shop (for CJ WOW Shop to send to purchasers). There is neither evidence nor reason why CJ WOW Shop would sell counterfeit defendant's *telekung*; and

(2) if exhs P2 and P3 were not the defendant's *telekung*:

   (a) the defendant would have complained to CJ WOW Shop regarding exhs P2, P3 and P4;

   (b) the defendant should have called a witness from CJ WOW Shop to give evidence to rebut the rebuttable presumption. If CJ WOW Shop does not co-operate with the defendant, the defendant can apply for a subpoena to compel the relevant employee from CJ WOW Shop to testify regarding exhs P2, P3 and P4; or

   (c) the defendant should have instituted third party proceedings against CJ WOW Shop for an indemnity for damages and costs (due to exhs P2, P3 and P4). In fact, the defendant could have filed a counterclaim against CJ WOW Shop for the tort of passing off

exhs P2 and P3 as the defendant's *telekung*.

All the matters stated in the above sub-paras 2(a) to (c) have not been done by the defendant. This can only prove that exhs P2 and P3 are indeed the defendant's *telekung*.

[14] An adverse inference under s 114(g) of the EA may be drawn by the court against a party for suppressing material evidence — please see Mohd Azmi SCJ's judgment in the Supreme Court case of *Munusamy v Public Prosecutor* [1987] 1 MLJ 492 at p 494. In this case, I cannot draw an adverse inference under s 114(g) of the EA against the plaintiff regarding exhs P2, P3 and P4 because:

(1) the plaintiff can rely on ss 4(1) and 114(f) of the EA — please see the above paras 10–12; and

(2) the plaintiff did not suppress any material evidence in this case.

D(2). Should court attach weight to exh D6?

[15] I am not able to attach any weight to exh D6 because:

(1) SP1 was cross-examined at length and yet, exh D6 was not adduced as evidence by the defendant during SP1's cross-examination. Hence, SP1 (creator of the design of the plaintiff's *telekung*), was deprived of the opportunity to examine exh D6 and to adduce her testimony regarding exh D6; and

(2) exh D6 was only introduced through SD1 after the plaintiff had closed its case. The defendant did not apply to recall SP1 under s 138(4) of the EA for further cross-examination regarding exh D6. Section 138(4) of the EA provides as follows:

> 138(4) *The court may in all cases permit a witness to be recalled* either for further examination-in-chief or *for further cross-examination*, and if it does so, the parties have the right of further cross-examination and re-examination respectively. (Emphasis added.)

I have not overlooked para 4 of the consent order dated 28 September 2017 (para 4) wherein both the plaintiff and defendant have agreed that any failure to put or suggest any fact and proposition to any witness, does not amount to an acceptance of the fact and proposition. Paragraph 4 does not apply to exhs tendered by parties in this case as evidence for the very first time during the trial. If any weight is attached to exh D6, there will be an injustice to the plaintiff in this case.

E. CREDIBILITY OF WITNESSES

[16] I find as a fact that SP1 is a credible witness. This finding is based on the following evidence and reasons:

(1) SP1's testimony is supported by documentary evidence (which I will elaborate in sub-paras 31(3) and (4) below regarding SP1's creation of the design of the plaintiff's *telekung*); and

(2) the cross-examination of SP1 does not show any reason to doubt her veracity.

[17] It is this court's finding of fact that SD1 lacks credibility. This is due to the following evidence and reasons:

(1) SD1 initially claimed that the defendant's *telekung* is based on a common design of telekung which is freely available. Such evidence is materially contradicted by SD1's subsequent testimony that the defendant's *telekung* is an 'enhanced' version of commonly available *telekung*. SD1's credibility is further undermined when he stated that the lace, cloth and rubber used in the defendant's *telekung* are very different from those used in the plaintiff's *telekung*. If both the plaintiff's *telekung* and defendant's *telekung* are based on common designs which are freely available in the public domain (as alleged by SD1), there should not be any material difference between both *telekung*;

(2) SD1 is now in his tenth year as the defendant's Sales GM and yet, when cross-examined, he was unsure how many defendant's *telekung* have been sold;

(3) SD1 admitted during cross-examination that as the defendant's Sales GM, he had advised the two designers of the defendant's *telekung* ('defendant's designers'). The defendant's designers, according to SD1, are from Bangladesh. SD1 however does not know the names of the defendant's designers. The defendant has disputed that SP1 created the design of the plaintiff's *telekung* and has instead alleged that the defendant's designers had enhanced commonly available *telekung* in the defendant's *telekung*. In such circumstances, it is inconceivable for SD1 (as the defendant's Sales GM) not to know the names of the defendant's designers; and

(4) during cross-examination, SD1 agreed that the defendant had not adduced any photograph to show that *telekung* had been in use for many years. SD1 also agreed that the defendant has no evidence that this action has been filed by the plaintiff in a mala fide manner. It is difficult to believe a witness who makes bold assertions without any documentary proof.

F. WHETHER *TELEKUNG* IS A 'GRAPHIC WORK' OR 'WORK OF ARTISTIC CRAFTSMANSHIP' UNDER THE CA

[18] The defendant has contended that a *telekung* constitutes a 'work of artistic craftsmanship' as explained by the following decisions of English courts:

(1) the House of Lords's decision in *George Hensher Ltd v Restawile Upholstery (Lancs) Ltd* [1975] RPC 31; and

(2) the High Court's judgment in *Merlet & Anor v Mothercare Public Ltd* [1984] FSR 358.

[19] I reproduce the relevant parts of s 3 of the CA as follows:

> s 3 *Interpretation*
>
> *'artistic work' means —*
>
> (a) *a graphic work*, ... *irrespective of artistic quality*;
>
> ...; or
>
> (c) *a work of artistic craftsmanship*,
>
> ...
>
> *'graphic work' includes —*
>
> (a) *any* ... *drawing*, ...
>
> ... (Emphasis added.)

[20] *George Hensher Ltd* concerned United Kingdom's (UK) then applicable Copyright Act 1956 ('the CA 1956 (UK)'). The CA 1956 (UK) has now been repealed by UK's Copyright, Designs and Patents Act 1988. Section 3(1) of the CA 1956 (UK) (regarding the definition of an 'artistic work' which includes a 'work of artistic craftsmanship') is similar to our definition of 'artistic work' (which also includes a 'work of artistic craftsmanship') in s 3 of the CA. Accordingly, I am of the view that Malaysian courts may refer to *George Hensher Ltd* in the interpretation of 'artistic work' and a 'work of artistic craftsmanship' in s 3 of the CA.

[21] In *George Hensher Ltd*, the five judges in the House of Lords were not unanimous regarding the meaning of a 'work of artistic craftsmanship'. Four views regarding a 'work of artistic craftsmanship' have been expressed in *George Hensher Ltd* ('four views') as follows:

(1) Lord Reid, at p 54, held that a 'work of artistic craftsmanship' is a work which 'any substantial section of the public genuinely admires and values

... for its appearance and gets pleasure or satisfaction, whether emotional or intellectual, from looking at (the work)';

(2) according to Lord Morris, at p 57, whether a work is one of 'artistic craftsmanship' is a question of fact to be decided objectively based on the evidence and this goes beyond a mere appeal to the eye. This view has also been stated by Viscount Dilhorne, at p 62;

(3) Lord Simon, at p 66, decided that the phrase 'work of artistic craftsmanship' is a composite one which 'must be construed as a whole' and refers to a work which 'at least presupposes special training, skill and knowledge' to produce the work; and

(4) Lord Kilbrandon, at pp 71–72, firstly held that a 'work of artistic craftsmanship' is one which comes into existence as a product of its author 'who is consciously concerned to produce' the work. Lord Kilbrandon then decided that whether a work is 'artistic' or not, is a question to be decided by the judge and not by witnesses or experts.

[22] The definition of 'graphic work' in s 3 of the CA uses the term 'includes' and not the word 'means'. The use of the word 'includes' in the definition of 'graphic work' has the effect of widening the scope of that definition — please see the Federal Court's judgment delivered by Raja Azlan Shah CJ (Malaya) (as His Majesty then was) in *Haji Abdul Ghani bin Ishak & Anor v Public Prosecutor* [1981] 2 MLJ 230 at pp 245–246.

[23] Firstly, I find that SP1's three two-dimensional drawings regarding the design of the plaintiff's *telekung* (SP1's drawings) constitute a 'graphic work' in s 3(a) of the CA — please see Azahar Mohamed J's judgment in the High Court case of *Radion Trading Sdn Bhd v Sin Besteam Equipment Sdn Bhd & Ors* [2010] 9 MLJ 648; [2010] 6 CLJ 334 at paras 20–23. I further find that the three-dimensional plaintiff's *telekung* (produced based on two-dimensional SP1's drawings), in itself, constitutes an 'artistic work' in s 3(a) of the CA — *Radion Trading* at paras 20–23.

[24] I find that the plaintiff has not adduced any evidence to prove that the plaintiff's *telekung* is a 'work of artistic craftsmanship' in s 3(c) of the CA within the meaning of any one or more of the four views. As such, based on the evidence in this case, the plaintiff's *telekung* is not a 'work of artistic craftsmanship' in s 3(c) of the CA.

G. IS *TELEKUNG* ELIGIBLE FOR COPYRIGHT UNDER CA?

[25] The defendant has relied on Anantham Kasinather JCA's judgment in the Court of Appeal case of *The New Straits Times Press (M) Bhd & Anor v Admal Sdn Bhd* [2013] 6 MLJ 405; [2013] 9 CLJ 955 ('NST's case') to

submit that a *telekung* is not eligible for copyright under CA due to its religious function (for prayers).

[26] *NST*'s case concerns the issue of whether the concept of an English spelling competition is eligible for copyright under CA. The Court of Appeal held in *NST*'s case at paras 21–24, as follows:

> [21] ... *it is common ground that all that the respondent did in this case was really to compile information from various sources including from American Spelling Bee competition. This was unreservedly confirmed by PW2 and PW3 themselves* ...
>
> [22] *In this case, we are not persuaded that the NST Spell It Right although capable of securing copyright is entitled to such protection since it is nothing more than the mere compilation of already existing information widely available in the public sphere. It is not in dispute that the NST Spell It Right concept is really a compilation of rules and regulations to regulate the holding of a spelling competition and such competitions have been around for ages. Indeed, in this case, the respondent readily admitted to having copied the idea and concept behind the NST Spell It Right from the American Spelling Bee competition. This was unreservedly confirmed by PW2 and PW3 themselves. In the face of this admission, in our opinion, it was necessary for the respondent to demonstrate what features were the result of its efforts so as to satisfy the originality test pronounced by Justice Abdul Malik Ishak in Kiwi Brand (M) Sdn Bhd v Multiview Enterprises Sdn Bhd. With respect, we are unable to discover anything novel or original in the concept behind NST Spell It Right beyond that already available in the public domain* ...
>
> [23] In our judgment, *apart from the absence of any originality behind the concept of NST Spell It Right, the learned trial judge failed to take into account the 'functional object' behind competitions of this nature. The meaning and relevance of 'functional object' in determining infringement of copyright was put this way in the case of Flamelite (S) Pte Ltd and Others v Lam Heng Chung and Others:*
>
> > *To answer this question the whole of the work must be considered and in this exercise the originality and simplicity of the plan and its functional object must be borne in mind* (para 40).
> >
> > ...
>
> [24] *Applying the principles of law governing the 'functional object' test to the concept behind the NST Spell It Right, we are inclined to agree with the written submission of learned counsel for the appellant that the concept is not eligible for copyright because*:
>
> (i) *The concept contains features which relate to the very function of any competition to be held among students residing and schooling in different parts of the country. The fact that this concept concerns a spelling competition does not per se give rise to any originality since every competition of this nature must necessarily involve similar rules and regulations with minor variations*;
>
> (ii) *The information in relation to a spelling competition is common knowledge since apart from being available in the public domain, competitions are frequently organised by social clubs such as rotary and the competition is usually organised among schools within the district. The need to alter some*

features of the competition to accommodate the fact that this is a spelling competition and involves the whole country, with respect, does not detract from the fact that this is a common event and the rules and regulations governing it fairly commonplace;

(iii) ...;

(iv) *It is common ground that spelling competitions have been held and continue to be held throughout the world and the concept of the competition is freely available on television and the internet.*

... (Emphasis added.)

[27] According to s 6 of the CA, no copyright shall subsist otherwise than by virtue of CA. Whether a piece of 'artistic work' (as understood in ss 3 and 7(1)(c) of the CA) can be protected by copyright under CA depends on whether all the following conditions under CA (conditions) have been fulfilled:

(1) s 7(3)(a) of the CA provides that an artistic work shall not be eligible for copyright unless sufficient effort had been expended to make the work original in character. The following cases are relevant in the interpretation of s 7(3)(a) of the CA:

(a) in the Federal Court case of *Lau Foo Sun v Government of Malaysia* [1974] 1 MLJ 28, Ali FJ held that copyright only protects *originality of expression* in the work and not originality of ideas or thoughts in the work; and

(b) Abdul Malik Ishak J (as he then was) decided as follows in the High Court in *Kiwi Brands (M) Sdn Bhd v Multiview Enterprises Sdn Bhd* [1998] 6 MLJ 38; [1998] 2 CLJ Supp 194 at pp 201–202:

> ... *It seems that copyright subsists only in an original literary work as envisaged under s 7(3)(a) of the CA. Halsbury's Laws of England, 4th Ed, Vol 9, at para 831 expresses an opinion that it is not necessary that 'the work should be the expression of original or inventive thought, for Copyright Acts are not concerned with the originality of ideas, but with the expression of thought, and in the case of a literary work, with the expression of thought in print or writing'*. (Emphasis added.)

The decision in *Kiwi Brands Malaysia* has been followed by Dr Badariah Sahamid JCA in the recent Court of Appeal case of *Elias bin Idris v Mohd Syamsul bin Md Yusof & Ors*, Civil Appeal No W-02(IPCV) (W) 508–03 of 2016 ('*Elias*'s case');

(2) in accordance with s 7(3)(b) of the CA, the artistic work has been written down, recorded or reduced to 'material form' (defined in s 3 of the CA);

(3) the artistic work qualifies for copyright protection due to one or more of the following reasons:

A (a) the work is made by a 'qualified person' (defined in s 3(a) and (b) of the CA as, among others, a Malaysian citizen and Malaysian company respectively) — please see s 10(1) of the CA;

(b) the work is first 'published' in Malaysia — please see s 10(2)(a) of the CA. Section 4(1)(a) of the CA deems an artistic work to be 'published' only if copies of the work have been made available with the consent of the author of the work in a manner sufficient to satisfy the reasonable requirements of the public, whether by sale or otherwise; or

C (c) the work is made in Malaysia — please see s 10(3) of the CA; and

(4) there is no copyright protection:

(a) for 'any idea, procedure, method of operation or mathematical concept' — please see s 7(2A) of the CA and *Chuah Aik King (sole proprietor of Syarikat B Three Technology) v Keydonesoft Sdn Bhd* [2018] MLJU 530 at paras 18 and 28(2). Section 7(2A) of the CA has been inserted by way of Copyright (Amendment) Act 1997. If Parliament has intended that a purely functional work is not protected by copyright, Parliament would have expressly provided as such in s 7(2A) of the CA. The Legislature however has chosen not to do so in s 7(2A) of the CA. Furthermore, s 7(2A) of the CA provides that works shall be protected by copyright 'irrespective of ... the purpose for which they were created'; and

F (b) if the design in question has been registered under the Industrial Designs Act 1996 ('the IDA') — please see s 7(5) of the CA.

[28] I am of the view that if all the conditions are fulfilled, a *telekung* (including the plaintiff's *telekung*) is eligible for copyright protection under CA. *NST*'s case did not discuss s 7(2A) of the CA. In any event, *NST*'s case can be easily distinguished from this case as follows:

(1) in *NST*'s case, the information regarding a spelling competition is freely available in public domain and the respondent company had admitted copying the 'idea' and compiling information from various sources regarding spelling competitions. As explained in para 31 below, the plaintiff's *telekung* has been created (not copied) by SP1 because SP1 has expended sufficient effort, time and expense to make the plaintiff's *telekung* original in character within the meaning of s 7(3)(a) of the CA; and

(2) the 'idea' regarding a spelling competition cannot be protected by copyright under s 7(2A) of the CA — *Chuah Aik King*. However, a *telekung*, such as the plaintiff's *telekung*, is not solely an 'idea'. Nor is the plaintiff's *telekung* purely functional (for prayers). As testified by SP1 (in

sub-paras 31(1)(a) to (c) below), the plaintiff's *telekung* not only enables its user ('user') to pray but also gives comfort and elegance to the user.

H. WHETHER THE PLAINTIFF OWNS COPYRIGHT IN THE PLAINTIFF'S TELEKUNG

H(1). Who created the plaintiff's telekung?

[29] According to s 3(c) of the CA, the 'author' of an 'artistic work' (other than photographs) is the 'artist' of the work.

[30] At the trial, SP1 has adduced exh P1 as a piece of the plaintiff's *telekung* which has been created by SP1 and sold by the plaintiff. The defendant has not adduced any evidence to rebut the plaintiff's evidence that exh P1 embodies the plaintiff's *telekung* as created by SP1.

[31] There is ample proof that SP1 is the 'author' of the plaintiff's *telekung* within the meaning of s 3 of the CA. This is clear from the following evidence:

(1) SP1's witness statement had described in detail how SP1 designed the plaintiff's *telekung* over a period of six months in 2010. SP1 had used her skill and time, through trial and error, to design, measure, sew, choose the pattern and cloth material for the plaintiff's *telekung*. SP1 had also incurred expenses in creating the plaintiff's *telekung*.

According to SP1, the plaintiff's *telekung* has the following unique features:

(a) the use of the plaintiff's *telekung* will not leave any mark on the user's forehead;

(b) the users will be comfortable when they perform prayers; and

(c) the users will appear elegant;

(2) at the trial, SP1 gave oral evidence regarding the five essential components of the plaintiff's *telekung*. During cross-examination, SP1 testified that she started to design *telekung* in 2009. SP1 further stated that she has the ability and interest in designing *telekung*. SP1 also stated that she is the *telekung* designer for the plaintiff;

(3) SP1's testimony is supported by the following contemporaneous documents:

(a) SP1's drawings;

(b) a record of SP1's measurements (in SP1's own handwriting) concerning the plaintiff's *telekung* ('SP1's measurements'); and

(c) photographs of the different stages of SP1's design of the plaintiff's

telekung ('photographs');

(4) the January 2011 issue of 'Wanita' magazine featured an article with the title 'PADZILAH (SP1) TERAJUI IDENTITI telekung'. This article stated that, among others, SP1 designed the plaintiff's *telekung* based on her own creativity.

An article entitled 'TELEKUNG SITI KHADIJAH — keselesaan diutamakan' (published in the September 2012 issue of 'Al-Islam' magazine) stated that, among others, SP1 created the plaintiff's *telekung*.

The above two articles (two articles) had been written by independent third parties with no interest in the outcome of this suit. Furthermore, there is no complaint from any party (including the defendant) that the contents of the two articles were erroneous or false; and

(5) the plaintiff's *telekung* has been extensively advertised, promoted and marketed. If SP1 were not the author of the plaintiff's *telekung*:

(a) the true creator of the plaintiff's *telekung* would have filed a suit against the plaintiff and SP1 regarding the authorship and copyright in the plaintiff's *telekung*. No such action has been instituted; and

(b) the true author of the plaintiff's *telekung* would have lodged a complaint with the Enforcement Division of the Ministry of Domestic Trade, Co-operatives and Consumerism that the plaintiff has committed an offence of applying a false trade description to the plaintiff's *telekung* under s 5(1)(a) of the Trade Descriptions Act 2011 ('the TDA'). Neither investigation nor prosecution under TDA has been instituted against the plaintiff and/or SP1 in this case.

[32] During cross-examination, SP1 stated that she had obtained a certificate in 'Usuluddin' (Islamic theology) from University of Malaya. SP1 admitted that she did not have any formal qualification in arts or design from any institution. SP1 also assisted SP2's business (to detect underground utilities before commencement of excavation work). Such evidence, in my view, does not negate in any manner SP1's evidence regarding her creation of the plaintiff's *telekung* because:

(1) a creator of a *telekung* may be innately talented. There is therefore neither necessity nor requirement for formal or academic training and qualification for such a work; and

(2) even if a creator of a *telekung* is not innately talented, he or she may have derived his or her artistic ability from a pursuit of his or her hobby regarding *telekung* and/or from work experience regarding *telekung*.

[33] I find as a fact that the defendant's *telekung* is not created by the defendant or the defendant's designers because: A

(1) the defendant did not call either one of the two defendant's designers to testify in this case regarding the creation of the defendant's *telekung*;

(2) the drawings and designs of the defendant's *telekung* by the defendant's designers ('defendant's drawings') had not been adduced as evidence in this case. Such a fact is admitted by SD1 during cross-examination. I am not able to accept SD1's explanation that the defendant's drawings could not be tendered as evidence in this trial because the defendant has extensive experience in mass production of *telekung*; and B C

(3) the defendant has not given any evidence regarding:

(a) why the defendant cannot call one of the two defendant's designers to give evidence in this case; and

(b) the failure to produce the defendant's drawings in this case. D

In the circumstances, this court is constrained to draw an adverse inference against the defendant under s 114(g) of the EA for the suppression of the above material evidence. In *Guthrie Sdn Bhd v Trans-Malaysian Leasing Corp Bhd* [1991] 1 MLJ 33 at pp 34–35, Hashim Yeop Sani CJ (Malaya) in the Supreme Court affirmed the High Court's decision which drew an adverse inference under s 114(g) of the EA against a defendant. E

H(2). Whether all conditions have been fulfilled F

[34] I find as a fact the plaintiff owns copyright in the plaintiff's *telekung* because all the conditions have been met as follows:

(1) in accordance with s 7(3)(a) of the CA, sufficient effort has been expended by SP1 to make the plaintiff's *telekung* original in character — please see the above sub-para 31(1); G

(2) the plaintiff's *telekung* has been reduced to 'material form' within the meaning of s 3 (any form (whether visible or not) of storage from which the work ... or a substantial part of the work ... can be reproduced) read with s 7(3)(b) of the CA; H

(3) all the three alternative conditions in s 10(1), (2)(a) and (3) of the CA have been fulfilled as follows:

(a) the plaintiff's *telekung* is made by SP1, a Malaysian citizen, who is a 'qualified person' under s 3(a) of the CA; I

(b) the plaintiff's *telekung* is first 'published' in Malaysia within the meaning of s 4(1)(a) of the CA because it is first sold in Malaysia on 7 January 2011 (based on SP2's witness statement); and/or

(c) the plaintiff's *telekung* is made in Malaysia; and

(4) s 7(2A) and (5) of the CA do not bar the plaintiff's copyright. SP1 has testified during cross-examination that the design in the plaintiff's *telekung* has not been registered as an industrial design under IDA.

H(3). Effect of SP2's SD

[35] Additionally or alternatively, pursuant to s 42(1)(a) of the CA, SP2's SD 'shall be admissible in evidence' and 'shall be prima facie evidence' that the plaintiff is the owner of copyright in the plaintiff's *telekung* — please see Jeffrey Tan FCJ's judgment in the Federal Court case of *Dura-Mine Sdn Bhd v Elster Metering Ltd & Anor* [2015] 3 MLJ 1; [2015] 1 CLJ 887 at paras 12 and 29. Exhibited in SP2's SD are SP1's drawings, SP1's measurements and photographs. I find as a fact that the prima facie evidence of the plaintiff's copyright in SP2's SD has not been rebutted by any credible evidence adduced by the defendant. On the contrary:

(1) SD1 is not a credible witness (please see the above para 17); and

(2) an adverse inference under s 114(g) of the EA is drawn against the defendant for suppressing material evidence regarding the defendant's designers and defendant's drawings (please see the above sub-para 33(3)).

I. HAS PLAINTIFF'S COPYRIGHT CEASED UNDER S 7(6) OF THE CA?

[36] Subsection 7(6) of the CA came into force on 1 September 1999 by way of Copyright (Amendment) Act 1996 and stated as follows:

> *Copyright in any design which is capable of being registered under any written law relating to industrial design, but which has not been so registered, shall cease as soon as any article to which the design has been applied has been reproduced more than fifty times by an industrial process by the owner of the copyright or, with his license, by any other person.* (Emphasis added.)

[37] The defendant has submitted that even if it was assumed that the plaintiff owned copyright in the plaintiff's *telekung*, by reason of s 7(6) of the CA, the plaintiff's copyright had ceased when more than 50 plaintiff's *telekung* were reproduced in 2010.

[38] With effect from 1 March 2012, Act A1402, among others, repealed sub-s 7(6). Subsection 7(6) of the CA is therefore enforceable from 1 September 1999 to 29 February 2012 (enforcement period of s 7(6) of the CA).

[39] The definitions of 'article' and 'industrial design' in s 3 of the IDA are as follows:

> *'article' means any article of manufacture or handicraft, and includes any part of such article or handicraft if that part is made and sold separately* but does not include an integrated circuit or part of an integrated circuit within the meaning of the Layout-Designs of Integrated Circuits Act 2000 [Act 601], or a mask used to make such an integrated circuit;
>
> *'industrial design' means features of shape, configuration, pattern or ornament applied to an article by any industrial process or means, being features which in the finished article appeal to and are judged by the eye, but does not include —*
>
> (a) *a method or principle of construction*; *or*
>
> (b) *features of shape or configuration of an article which —*
>
> (i) *are dictated solely by the function which the article has to perform*; *or*
>
> (ii) *are dependent upon the appearance of another article of which the article is intended by the author of the design to form an integral part*; (Emphasis added.)

[40] I am not able to accept the defendant's contention based on the then applicable s 7(6) of the CA. My reasons are as follows:

(1) sub-s 7(6) of the CA applies to 'any design which is capable of being registered' under IDA. Section 11 of the IDA provides that the 'original owner' of an 'industrial design' is entitled to apply for the registration of the 'industrial design' under IDA. Accordingly, for a design to be registered under IDA, the design must fall within the definition of an 'industrial design' in s 3 of the IDA which has the following three elements (three elements):

(a) the first element ('first element') is that an 'industrial design' means 'features of shape, configuration, pattern or ornament' 'which in the finished article appeal to and are judged by the eye' ('eye appeal features');

(b) the eye appeal features are 'applied to an article by any industrial process or means' ('second element'); and

(c) the eye appeal features cannot include any of the matters stated in s 3(a) or (b) of the IDA ('third element').

In the Court of Appeal case of *F & N Dairies (M) Sdn Bhd v Tropicana Products Inc and other appeals* [2013] MLJU 1591 at paras 24–52, Ramly Ali JCA (as he then was) has explained the meaning of the first and third elements;

(2) the plaintiff's *telekung* is not applied to an 'article' (as defined in s 3 of the IDA) 'by any industrial process or means'. Accordingly, the second

element is not fulfilled in respect of the plaintiff's *telekung*. On this ground alone, the plaintiff's *telekung* cannot constitute an 'industrial design' in s 3 of the IDA and is not 'capable of being registered' under IDA within the meaning of s 7(6) of the CA;

(3) the defendant has alleged a particular fact, namely the plaintiff's copyright has ceased under s 7(6) of the CA (particular fact). Under s 103 of the EA, the defendant has the burden to prove the particular fact. The defendant has failed to discharge the burden under s 103 of the EA to prove the particular fact because no evidence has been led by the defendant to prove the three elements; and

(4) assuming that I have erred in giving a literal interpretation of CA and IDA in the above sub-para (1), I have no hesitation to adopt a purposive interpretation of s 7(6) of the CA. The CA and IDA have been enacted after 18 May 1967. As such, Part I of the Interpretation Acts 1948 and 1967 ('the IA') applies to interpret CA and IDA — please see s 2(1)(b) of the IA. Section 17A of the IA (in Part I of the IA) provides as follows:

> 17A *Regard to be had to the purpose of Act*
>
> *In the interpretation of a provision of an Act, a construction that would promote the purpose or object underlying the Act (whether that purpose or object is expressly stated in the Act or not) shall be preferred to a construction that would not promote that purpose or object*. (Emphasis added.)

In *Palm Oil Research and Development Board Malaysia & Anor v Premium Vegetable Oils Sdn Bhd & another appeal* [2005] 3 MLJ 97; [2004] 2 CLJ 265, the Federal Court has relied on s 17A of the IA to give a purposive construction of a taxing statute.

In accordance with s 17A of the IA, I give a purposive and non-literal construction of s 7(6) of the CA, the definitions of 'article' and 'industrial design' in s 3 of the IDA by deciding that a *telekung* is not an 'industrial design' in s 3 of the IDA and s 7(6) of the CA does not therefore apply to a *telekung*. If I have accepted the defendant's above submission that a *telekung* is an 'industrial design' in s 3 of the IDA (to which s 7(6) of the CA applies):

(a) this would not 'promote the purpose or object underlying' IDA and CA; and

(b) an injustice and absurdity would result as follows — for the enforcement period of s 7(6) of the CA, owners of copyright in all *telekung* (which have been produced more than 50 times) would lose their copyright!

J. WHETHER DEFENDANT HAS INFRINGED THE PLAINTIFF'S COPYRIGHT

[41] Section 36(1) of the CA provides as follows:

> 36 *Infringements*
>
> (1) *Copyright is infringed by any person who does*, or causes any other person to do, *without the licence of the owner of the copyright, an act the doing of which is controlled by copyright under this Act*. (Emphasis added.)

[42] Section 36(1) of the CA has two limbs — please see *Motordata Research Consortium Sdn Bhd v Ahmad Shahril bin Abdullah & Ors* [2017] MLJU 1187; [2017] 7 AMR 560 at paras 49–50. The two limbs of s 36(1) of the CA are:

(1) when a person ('X') does an act which is controlled by copyright under the CA ('first limb'); and

(2) when a person causes X to do an act which is controlled by copyright under the CA ('second limb').

[43] This case does not concern the second limb. The first limb concerns a copyright infringement regarding 'an act the doing of which is controlled by copyright'. The plaintiff's copyright in the plaintiff's *telekung* means that the plaintiff has the following exclusive rights:

(1) the exclusive right under s 13(1)(a) of the CA to control the 'reproduction' (defined widely in s 3 of the CA) of the plaintiff's *telekung* in a 'material form' (defined in s 3 of the CA); and

(2) the exclusive right under s 13(1)(e) of the CA to control the distribution of the plaintiff's *telekung* to the public by sale or transfer of ownership.

[44] It is not disputed that the defendant has produced and distributed (by way of sale or transfer of ownership) the defendant's *telekung*. To prove copyright infringement under the first limb (the defendant has reproduced and distributed the plaintiff's *telekung*), the plaintiff has to prove all the following three elements (three elements (first limb)):

(1) there is a sufficient objective similarity between the plaintiff's *telekung* and the defendant's *telekung* (first element (first limb));

(2) there is a causal connection between the plaintiff's *telekung* and the defendant's *telekung* (second element (first limb)); and

(3) what has been copied in the defendant's *telekung* must constitute a

substantial part of the plaintiff's *telekung* (third element (first limb)).

The three elements (first limb) has been explained by Low Hop Bing J (as he then was) in the High Court case of *Megnaway Enterprise Sdn Bhd v Soon Lian Hock (sole proprietor of the firm Performance Audio & Car Accessories Enterprise)* [2009] 3 MLJ 525 at para 41. *Megnaway Enterprise* has been applied by the Court of Appeal in *Elias*'s case at para 31.

[45] To decide the first element (first limb):

(1) the court has to make a visual comparison between the plaintiff's *telekung* and the defendant's *telekung* (visual comparison) — *Megnaway Enterprise* at para 46;

(2) for the purpose of the visual comparison, the plaintiff's *telekung* is exh P1 while the defendant's *telekung* is represented by exhs P2 and P3 (please see the above Part D(1)). For reasons stated in the above Part D(2), I do not give any weight to exh D6; and

(3) based on the visual comparison, I accept the testimonies of SP1 and SP2 that there is a sufficient objective similarity between exh P1 on the one hand and exhs P2 and P3 on the other hand ('sufficient objective similarity'). The sufficient objective similarity is as follows:

(a) the design and pattern on the top part of the plaintiff's *telekung* and defendant's *telekung* are similar;

(b) the measurements of the face opening and the forehead part of the plaintiff's *telekung* and defendant's *telekung* are similar;

(c) the position of the tie string on the plaintiff's *telekung* and defendant's *telekung* is similar;

(d) the material on the forehead part of the plaintiff's *telekung* and defendant's *telekung* is similar; and

(e) the rubber lace liner (pelapik) on the plaintiff's *telekung* and defendant's *telekung* is similar.

[46] Regarding the second element (first limb):

(1) once the plaintiff has proven the first element (first limb) (sufficient objective similarity), there is a rebuttable presumption that the defendant has copied the plaintiff's *telekung* and the evidential burden then shifts to the defendant to disprove the second element (first limb) by proving that the defendant's *telekung* has been created independently of the plaintiff's *telekung* — *Megnaway Enterprise* at para 43; and

(2) the defendant has not adduced any credible evidence to prove that the defendant's *telekung* has been created without copying the plaintiff's *telekung*. On the contrary, I find that the rebuttable presumption (the defendant's *telekung* is copied from the plaintiff's *telekung*) is fortified by the following evidence and reasons:

(a) during cross-examination, SD1 agreed that the defendant's *telekung* was sold in the market subsequent to the plaintiff's *telekung*. In other words, the defendant could have easily bought the plaintiff's *telekung* in the market and could then produce the defendant's *telekung* by copying the plaintiff's *telekung*. I rely on the Court of Appeal's judgment in *Elias*'s case at para 39, as follows:

> [39] *It is worthy of note that evidence of a causal connection can be established directly or indirectly … In this case, the causal connection is indirect in that the original work had been published and was therefore available to the public. Thus the defendant would have had prior access to the novel. Even if the novel was no longer in the market, it would still presumably be available in libraries and bookstores. If we were to give a restrictive meaning to 'causal connection' as the learned judge did, it would leave a lot of original work unprotected, which is clearly not intended by (CA).* (Emphasis added.); and

(b) an adverse inference under s 114(g) of the EA is made against the defendant for suppressing material evidence regarding the defendant's designers and defendant's drawings (please see the above sub-para 33(3)).

[47] Concerning the third element (first limb):

(1) in *Syarikat Faiza Sdn Bhd & Anor v Faiz Rice Sdn Bhd & Anor and another suit* [2017] MLJU 1595 at sub-para 59(3), I have referred to the different tests regarding the third element (first limb) as follows:

(a) in the the House of Lords case of *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2001] 1 All ER 700 at pp 708–709, Lord Millett decided that:

(i) whether an impugned work has copied a substantial part of the copyright work depends on the quality (not the quantity) of the features of the copyright work which has been copied by the impugned work ('qualitative test'); and

(ii) the features copied by the impugned work need not form a substantial part of the impugned work. The importance of the impugned work is therefore not relevant in deciding whether the third element (first limb) has been fulfilled or not; and

(b) in *Designers Guild*, Lord Scott has distinguished the following two types of copying:

(i) the impugned work has copied an identifiable part of the copyright work without any modification ('direct copying'). In a case of direct copying, whether the third element (first limb) is proven depends on the quality of the copyright work's features which has been copied by the impugned work; and

(ii) the impugned work has copied the copyright work with modifications ('altered copying'). To decide whether the third element (first limb) has been satisfied in an altered copying case, Lord Scott adopted the test stated in *The Modern Law of Copyright and Designs*, Laddie, Prescott and Vitoria (2nd Ed, 1995), at para 2-108 — has the infringer incorporated in the impugned work a substantial part of the independent skill and labour of the author in creating the copyright work (Laddie's test)?;

(2) based on the qualitative test, I am satisfied that the defendant's *telekung* has copied a substantial part of the plaintiff's *telekung*. This is because the features regarding the sufficient objective similarity constitute a substantial part of the plaintiff's *telekung*; and

(3) additionally or alternatively, applying Lord Scott's decision:

(a) the sufficient objective similarity shows that the defendant's *telekung* has directly copied an identifiable part of the plaintiff's *telekung* ('identifiable part'). The quality of the identifiable part constitutes a substantial part of the plaintiff's *telekung*; or

(b) even if it is assumed that there is no identifiable part, this is an altered copying case because, on an application of Laddie's test, the defendant has incorporated in the defendant's *telekung* a substantial part of SP1's independent skill and labour in creating the plaintiff's *telekung*.

[48] Based on the evidence and reasons elaborated in the above paras 45–47, the plaintiff has proven the three elements (first limb) on a balance of probabilities against the defendant.

[49] In the Court of Appeal case of *Elster Metering Limited & Anor v Damini Corporation Sdn Bhd & Anor* [2012] MLJU 1753; [2012] 1 LNS 959 at para 12, Ramly Ali JCA (as he then was) held that a defendant cannot rely on the following defences in a copyright infringement suit:

(1) the defendant has no knowledge of the defendant's infringement of the plaintiff's copyright; and

(2) the defendant has no intention to infringe the plaintiff's copyright.

[50] Regarding the defendant's defence that the defendant was not aware of the plaintiff's copyright, I find as a fact that the defendant knew of the plaintiff's copyright. This decision is based on the following evidence and reasons:

(1) the plaintiff's *telekung* is introduced in the market before the defendant's *telekung*; and

(2) there has been extensive advertisement of the plaintiff's *telekung* in the mass media.

[51] Even if I have given the benefit of the doubt to the defendant and even if it is assumed that the defendant is oblivious to the plaintiff's copyright, I am of the view that the defendant's lack of knowledge of the plaintiff's copyright is not a defence to copyright infringement. Once a plaintiff has proven the three elements (first limb), there is a cause of action for copyright infringement pursuant to the first limb. Having said that, a defendant's lack of knowledge of a plaintiff's copyright is certainly a relevant factor for the court to decide whether to award the following damages for copyright infringement and their quantum:

(1) statutory damages (please see s 37(1)(d), (8)(c) and (8)(h) of the CA);

(2) additional damages (please see s 37(7)(c) of the CA);

(3) exemplary damages; and

(4) aggravated damages.

K. SUMMARY OF THE COURT'S DECISION

[52] In summary:

(1) pursuant to ss 4(1) and 114(f) of the EA, there is a rebuttable presumption that the common course of business regarding the plaintiff's purchase of the defendant's *telekung* (exhs P2 and P3) from CJ WOW Shop has been followed. There is no evidence adduced by the defendant to rebut the rebuttable presumption and on the facts of this case, the court attaches great weight to exhs P2 and P3;

(2) no weight is attached to exh D6 which is not tendered during the cross-examination of SP1 (author of the plaintiff's *telekung*) and exh D6 is only adduced after the close of the plaintiff's case;

(3) the plaintiff's *telekung* is a 'graphic work' as understood in s 3(a) of the CA and does not constitute a 'work of artistic craftsmanship' under s 3(c) of the CA;

(4) s 7(2A) of the CA does not bar copyright protection of a *telekung* on the ground that the *telekung* is purely functional. In any event, the plaintiff's

telekung is not purely functional so as to be disentitled to copyright under s 7(2A) of the CA;

(5) the plaintiff owns copyright in the plaintiff's *telekung* by reason of:

(a) the fulfilment of all the conditions; and/or

(b) SP2's SD which constitutes prima facie evidence of the plaintiff's copyright under s 42(1)(a) of the CA and such evidence has not been rebutted by the defendant;

(6) the plaintiff's copyright has not ceased under the previously applicable s 7(6) of the CA because the plaintiff's *telekung* does not constitute an 'industrial design' under s 3 of the IDA which can be registered under IDA; and

(7) the defendant has infringed the plaintiff's copyright under the first limb. In this regard, the defendant cannot claim that:

(a) the defendant is not aware of the plaintiff's copyright;

(b) the defendant has no knowledge of the copyright infringement; and

(c) the defendant does not intend to commit copyright infringement.

[53] The upshot is the plaintiff's suit is allowed with costs.

Plaintiff's suit allowed with costs.

Reported by Afiq Mohamad Noor